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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/755,427 | 01/12/2004 | Lee Bolduc | 203-2626 DIV CON VIII | 9695 |
| | 7590 | 12/15/2005 | (24) | |
| Mark Farber, Esq. U.S. Surgical, A Division of Tyco Healthcare Group, LP 150 Glover Avenue Norwalk, CT 06856 | | | EXAMINER | |
| | | | JACKSON, GARY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3731 | |

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,427

Applicant(s)

BOLDUC ET AL.

Examiner

Gary Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/23/.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/8/2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 recites the limitation "plurality of fasteners" in claim 2. There is insufficient antecedent basis for this limitation in the claim. .

Double Patenting

Claims 1-18 are rejected under the judicially created doctrine of obviousness type double patenting as being obvious over claim 11 of U. S. Patent No. 5,582,616.

The subject matter recited in claim 14 of the present application – An applicator for attaching fasteners to body tissue comprising: a distal portion having an elongate outer tube, a connecting end and a terminal end; a proximal portion having a handle and an actuator, the proximal portion being attached to the connecting end of the distal portion; and a rotator cooperating with the actuator and including a longitudinal groove extending along at least a portion of the length of the rotator, the groove configured to receive a portion of a fastener, wherein the rotator resides within and extends substantially the length of the outer tube such that actuation of the actuator rotates the fastener relative to the outer tube and the actuator includes: a lever having a first end, a midsection, and a second end, the first end pivotally attached to the handle, the midsection for gripping by hand; a lead screw rotatably attached to an interior of the handle; a nut driver, the second end pivotally attached to the nut driver, the nut driver for traveling along the lead screw, thereby turning the lead screw; and means for the

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lead screw to releasably engage the rotator so that as the lever is depressed by hand, the nut driver will travel along the lead screw toward the rotator thereby turning the rotator in the process and so that when the lever is returned to its undepressed position, the lead screw will rotate in the reverse direction and independently of the rotator which remains stationary. – The allowance of this claims would extend the right to exclude already granted in claim 11 of the patent – that right to exclude covering the an applicator for attaching fasteners to body tissue comprising: a distal portion having an elongate outer tube, a connecting end and a terminal end; a proximal portion having a handle and an actuator, said proximal portion attached to said connecting end of said distal portion; a rotator for receiving a plurality of fasteners and for cooperating with said actuator, said rotator configured to reside within and extend substantially the length of said outer tube; means for threading and ejecting the fastener out of said terminal end; and a load spring for biasing said plurality of fasteners to the terminal end and further comprising: a lock/clip indicator for engaging said plurality of fasteners; and said load spring for applying longitudinal forces against said lock/clip indicator and wherein said lock/clip indicator is configured to prevent actuation of said actuator upon discharge of said plurality of fasteners from the applicator.

It is clear that all of elements of claim 14 are found in claim 11 of the patent. The difference between claim 11 of the patent and claim 14 of the application lies in the fact that the patent claims include the element means for threading and ejecting the fastener out of said terminal end; and a load spring for biasing said plurality of fasteners to the terminal end. Thus claim 14 is in effect a “species” of the “generic” invention of claims

11. It has been held that the generic claim invention is "anticipated" by the "species".

See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 14 is anticipated by the claim 11 of the patent, it is not patentable distinct from claim 11.

Concerning claims 2-13 and 15-18, the transitional phrase "comprising" does not exclude the presence of elements other than claim 14 of the patent recited above.

Because of the phrase "comprising" the patent not only provides protection claim 14 of the patent, but also extends coverage to the disclosed elements in claims 2-14 and 15-18.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

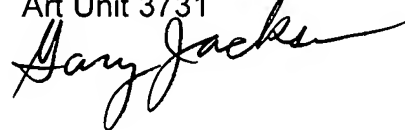
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gj
December 12, 2005

Gary Jackson
Primary Examiner
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A handwritten signature in black ink that reads "Gary Jackson". The signature is written in a cursive style with a long horizontal flourish extending to the right.